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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,169	11/13/2003	Bruce D. Williams	13-97	9814

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT PAPER NUMBER

1774

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/713,169

Applicant(s)

WILLIAMS ET AL.

Examiner

Lawrence D. Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/13/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Election***

1. This action is in response to the provisional election mailed January 12, 2006. (Group II) Claims 11-24 were provisionally elected rendering (Group I) Claims 1-10 to a non-elected invention, which are cancelled by Applicant. Because claims 1-10 are cancelled, the restriction requirement mailed December 14, 2005, is withdrawn.

### ***Claim Rejections – 35 USC § 102(b)***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 11-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Collings (U.S. 5,188,871).

Collings discloses verifying the authenticity of a coupon or paper by incorporating a chemical reagent in the paper which on being contacted by an authenticating composition will produce a characteristic colour change (column 1, lines 13-26 and 51-61) where starch is incorporated and the authenticating composition is an acidic solution, where the reaction creates a dark colouration (column 2, lines 31-44). Collings additionally discloses the starch may be applied by a coating or printing technique,

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where the printing may be in the form of a pattern (column 4, lines 61-68). The verification of the authenticity of the paper can be done using pens (column 5, lines 14-16). Because Collings discloses a method for verifying the authenticity of a coupon which comprises the same materials and functions as instantly claimed, it is inherent for the first material to have a lower starch content than non-currency grade paper and having a lower trace chemical residual content than non-currency grade paper.

***Claim Rejections – 35 USC § 102(b)***

4. Claims 11-14 and 16-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Ahlm, Jr. et al (U.S. 3,001,887).

Ahlm, Jr. discloses verifying the authenticity of a coupon having a surface printed with an indistinguishable material which will form initially colorless and inherently authenticating words, symbols or designs adapted to be developed in color upon the application of certain chemical agents (column 1, lines 9-45 and 55-65). Because Ahlm, Jr. discloses a method for verifying the authenticity of a coupon which comprises the same materials and functions as instantly claimed, it is inherent for the first material to have a lower starch content than non-currency grade paper and having a lower trace chemical residual content than non-currency grade paper.

***Claim Rejections – 35 USC § 103(a)***

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Collings (U.S. 5,188,871) in view Kurrle (U.S. 6,214,766).

Collings is relied upon for instant claims 11, 20 and 21. Collings does not explicitly disclose the printing process for applying the coated material to be a flexo device. Kurrle teaches a paper product made to be authenticatable by the application of a printed image containing starch applied to the paper product and where a solution added to the surface of the paper produces an instantaneous blue or black color (column 3, lines 20-31) where the coated printed material can be applied using a flexography printing process. Collings and Kurrle are both directed to verifying the authenticity of a paper product. It would have been obvious to one of ordinary skill in the art to have applied to coated printed material using flexography, as taught in Kurrle, in the paper or coupon of Collings to produce an improved layer of material on the surface of the paper which will not readily come off the surface.

***Claim Rejections – 35 USC § 103(a)***

7. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ahlm, Jr. et al (U.S. 3,001,887) in view Kurrle (U.S. 6,214,766).

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Ahlm, Jr. is relied upon for instant claims 11, 20 and 21. Ahlm, Jr. does not explicitly disclose the printing process for applying the coated material to be a flexo device. Kurrle teaches a paper product made to be authenticatable by the application of a printed image containing starch applied to the paper product and where a solution added to the surface of the paper produces an instantaneous blue or black color (column 3, lines 20-31) where the coated printed material can be applied using a flexography printing process. Ahlm, Jr. and Kurrle are both directed to verifying the authenticity of a paper product. It would have been obvious to one of ordinary skill in the art to have applied to coated printed material using flexography, as taught in Kurrle, in the paper or coupon of Ahlm, Jr. to produce an improved layer of material on the surface of the paper which will not readily come off the surface.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Krueger et al (U.S. 3,523,866) teaches an authenticatable paper containing a dye which is capable of producing a distinctive color upon treatment with a second component (column 1, lines 21-25).

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



L. Ferguson  
Patent Examiner  
AU 1774



RENA DYE  
SUPERVISORY PATENT EXAMINER

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